Supreme Court, U.S.
FILED
JUL 22 2015
OFFICE OF THE CLERK

No. 15-866

IN THE

Supreme Court of the United States

STAR ATHLETICA, L.L.C.,

Petitioner,

v.

VARSITY BRANDS, INC., *et al.*,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF OF *AMICUS CURIAE* NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY

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INTEREST OF *AMICUS CURIAE*[1]

The New York Intellectual Property Law Association ("NYIPLA" or "the Association") is a professional association of more than 1,300 attorneys whose interests and practices lie in the area of patent, trademark, copyright, trade secret and other intellectual property law.[2] The Association's members include a diverse array of attorneys specializing in intellectual property law, from in-house counsel for businesses that own, enforce and challenge copyrights, to attorneys in private practice who represent authors and copyright owners or distributors of copyrighted content in various proceedings before the courts and other tribunals that adjudicate copyright claims or set copyright royalty rates. A substantial percentage of the Association's member attorneys participate actively in copyright litigation, representing both copyright owners and accused infringers. In addition, the Association's members frequently engage in copyright licensing matters on their clients' behalf, representing both copyright licensors and licensees.

The arguments set forth herein were approved on July 19, 2016 by an absolute majority of the officers and

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1. Pursuant to Sup. Ct. R. 37.6, the NYIPLA and its counsel represent that they have authored the entirety of this brief, and that no person other than the *amicus curiae* or its counsel has made a monetary contribution to the preparation or submission of this brief.

2. Pursuant to Sup. Ct. R. 37.2(a), Petitioner consented to the filing of amicus briefs in support of either party or neither party in a docket entry dated May 10, 2016. Respondent consented to the filing of amicus briefs in support of either party or neither party in a docket entry dated May 17, 2016.

members of the Board of Directors of the Association, including officers or directors who did not vote for any reason, including recusal, but do not necessarily reflect the views of a majority of the members of the Association or of the law firms or corporate organizations with which those members are associated. After reasonable investigation, the Association believes that no officer or director of the Association, or member of the Association's Committee on Amicus Briefs who voted in favor of filing this brief, or any attorney associated with any such officer, director, or committee member, whether alone or in any law firm or corporate organization, represents a party in this litigation. Some officers, directors, committee members, or attorneys associated with them may represent entities, including other *amici curiae*, which have an interest in other matters that might be affected by the outcome of this litigation.

The entities served by the Association's members include authors, publishers, artists, broadcasters and other distributors of copyrighted content, entrepreneurs, venture capitalists, businesses, universities, and industry and trade associations. The Association's members and their respective clients have a strong interest in the issues presented by this case because their day-to-day activities depend on the consistently-applied principles of the Copyright Act, and its members have a particularly strong interest in ensuring that those principles are applied properly, fairly and consistently.

SUMMARY OF THE ARGUMENT

In this case, the Court is being asked to resolve an issue of copyright law that has generated nearly as many

tests as there are federal circuit courts: How should a court determine whether elements of a useful article merit copyright protection even if the article has a utilitarian function? In 1954, this Court confirmed that the original design of otherwise functional useful articles may be copyrightable. *Mazer v. Stein*, 347 U.S. 201, 217 (1954). In 1976, the Copyright Act codified this Court's holding in *Mazer*, recognizing that the law does not distinguish between a statue first published as a statue and then incorporated into an industrial article, and a statue first published as part of a useful article; both may be works of art meriting copyright protection. *See id.*

The sections of the Copyright Act relevant to this inquiry include 17 U.S.C. §§ 101, 113:

> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features **that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article**. 17 U.S.C. § 101 (emphasis added).

> A "useful article" is an article having an **intrinsic utilitarian function** that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article". 17 U.S.C. § 101 (emphasis added).

> Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise. 17 U.S.C. § 113(a).

> This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title. 17 U.S.C. § 113(b).

Courts have struggled to interpret this statutory language and distinguish between what is or is not copyrightable under these provisions, at least in part because the statute does not define what it means by "intrinsic utilitarian function." Nor does the statute provide a clear standard for determining how to separate a design from the utilitarian aspects of a useful article.

Consequently, courts struggle to identify when it is necessary to address separability and how to do so, resulting in nearly a dozen tests across the circuits that collectively invoke a multitude of sometimes overlapping factors.

Currently before the Court is the most recent framework developed to assess the copyrightability of the design of a useful article—a five-factor test developed by the Sixth Circuit. However, as discussed more fully below, the Sixth Circuit's framework is imprecise, inefficient, and may yield determinations inconsistent with the Copyright Act.

I. By way of background, this Court addressed the copyrightability of the design of a useful article in 1954 in *Mazer*, finding that a product's utility is not anathema to copyrightability. Design elements separable from utilitarian function may merit copyright protection. *Mazer* was codified as part of the Copyright Act in 1976, and courts have struggled to consistently apply the holding in *Mazer* as well as the statutory language around copyrightability of the design of useful articles. Numerous tests have emerged, further muddying the waters of whether and to what extent the design of a useful article is protectable by copyright. Certain of these tests are particularly inappropriate, since they are likely to lead to inefficient analysis or inconsistent and unpredictable results. *See infra* Part I.

II. In this case, the Court of Appeals for the Sixth Circuit created and applied a new, five-step framework for determining whether the design of a useful article merits copyright protection. The Sixth Circuit's test

is problematic, because it requires courts to begin by assessing the utility of the work at issue rather than the claimed design, which may unnecessarily expand the scope of the analysis. *See infra* Part II.

III. The Association is of the opinion that (1) a proper copyrightability analysis should begin with an understanding of the claimed *design*, rather than the underlying useful *article* and (2) the separability determination should be based on factors related to examination of the article itself, rather than external, subjective factors. Such a framework is more efficient, more consistent with the statutory framework, and likely to increase certainty in copyright law. *See infra* Part III.

In view of the foregoing, the Association proposes the following framework for determining whether the design of a useful article merits copyright protection:

(1) What are the design elements in which copyright is claimed?

(2) Are those elements original and fixed in a tangible medium of expression?

(3) Are those design elements inextricably intertwined with a utilitarian function of the object in which they are fixed such that they cannot be identified or exist apart from the object's utilitarian features?

In making this third determination, courts should be free to consider, without limitation, certain objective factors including:

(a) whether the claimed design elements are physically separable from the overall object;

(b) whether the claimed design elements are primary to a subsidiary function of the work;

(c) whether the claimed design and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article; and

(d) the extent to which the design at issue is dictated by the utilitarian aspects of the work.

While the Association takes no position at this time on the merits of the dispute between Petitioner and Respondent or on the Sixth Circuit's application of its framework to the facts at bar, we urge this Court to re-examine the Sixth Circuit's new copyrightability test, as well as the various other separability tests, in light of the statutory framework, considerations of judicial economy, and the need for certainty among copyright law stakeholders.

ARGUMENT

I. Background

The seminal case on copyright protection of the design of useful articles is this Court's holding in *Mazer v. Stein*, 347 U.S. 201 (1954). Recognizing that works of art need not be in a museum to merit copyright protection, the Court held that molded statuettes of human figures were copyrightable, despite the fact that the works were intended for use (and widely sold) as lamp bases. *Id* at 217.

Illus. 1. Statue Lamp Base from *Mazer* (*available at* http://coolcopyright.com/contents/chapter-4/mazer-v-stein (last visited Jul. 20, 2016).

In so holding, the court ruled that the owners of the copyright in the statuette in *Mazer* "may not exclude others from using statuettes of human figures in table lamps; they may only prevent use of *copies of their statuettes* as such or as incorporated in some other article." *Id.* at 218 (emphasis added). In 1976, the relevant sections of the Copyright Act were amended to codify this Court's holding in *Mazer*. However, as discussed further below, these amendments have led to decades of debate and inconsistency among the circuits.

A. The 1976 Amendments to the Copyright Act Codifying *Mazer v. Stein*

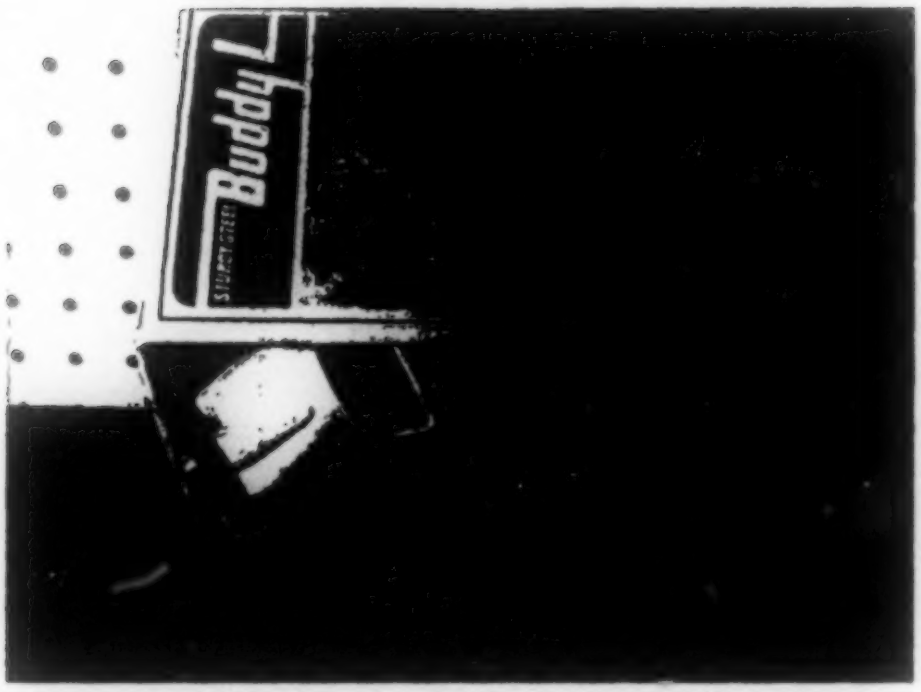
The 1976 Amendments to the Copyright Act relevant here introduced two new concepts: "intrinsic utilitarian function" and "separability."

The Act does not define "intrinsic utilitarian function." Courts have concluded that a given article may have many

uses and various functional aspects in addition to its "intrinsic utilitarian function." *See, e.g., Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 973 (6th Cir. 1983) ("Other than the portrayal of a real airplane, a toy airplane, like a painting, has no intrinsic utilitarian function"). Instead, the "intrinsic utilitarian function" derives from the reason the article came into being in that particular form. The intrinsic utilitarian function of a stapler, therefore, is to fasten papers together, notwithstanding that it might also be used as a paperweight or as a weapon. *See, e.g.*, Darren Hudson Hick, *Conceptual Separability and the Non-Usefulness of the Useful Articles Distinction*, 57 J. Copyright Society U.S.A. 37, 53 (2010).

The notion that objects possess readily identifiable and provable intrinsic utilitarian functions comes from a 1954 Copyright Office proposal, and, as aptly noted by William Patry, hearkens back to Plato's Theory of Forms. *See* 2 Patry on Copyright § 3:134. Indeed, the questions that courts grapple with regarding usefulness are at least in part questions of philosophy.

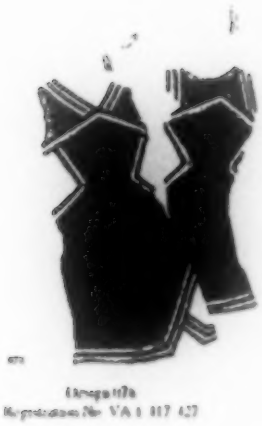
It is often not obvious what the intrinsic utilitarian function of an article is. Is a toy airplane useful because it "it permits a child to dream and to let his or her imagination soar," or is its only function is to portray a real plane? *Compare Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622 (E.D. Mich. 1981) ("*Gay I*") (finding a toy's intrinsic untilitarian function is to enable play), *with Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970 (6th Cir. 1983) (vacating and remanding *Gay I* because, "[o]ther than the portrayal of a real airplane, a toy airplane . . has no intrinsic utilitarian function"). Thus, it should not surprise this Court that determinations of an article's intrinsic utilitarian function are often difficult and unsatisfactory.



Illus. 2. ebay listing for Buddy L "Air Coupe" (*available at* http://ebay.to/29WAYMa (last visited Jul. 20, 2016)).

Consider, too, the dilemma of a clothing designer who picks up a small shirt at a flea market and is inspired to replicate some aspect of its design. If the shirt is a child's shirt, it is a useful article and copyright protection in its design would be limited only to separable elements, likely including the fabric design. If the shirt had been designed for a doll, however, it would likely be protectable in its entirety, because doll clothes are not functional. *See Mattel, Inc. v. MGA Entm't, Inc.*, 616 F.3d 904, 916 (9th Cir. 2010) ("Dolls don't feel cold or worry about modesty. The fashions they wear have no utilitarian function.")

In the instant case, Varsity Brands seeks copyright protection of the design of cheerleading uniforms.



Illus. 3. Cheerleading uniform design copyright (*available at* http://copyright.nova.edu/wp-content/uploads/2015/08/gimme6.jpg (last visited Jul. 20, 2016)).

Clothing designs and shapes serve the functional purposes of covering a person's body and providing protection from the elements. The shape and cut of skirts and dresses are deemed "functional" and not subject to protection. *See, e.g., Jovani Fashion, Inc. v. Cinderella Devine, Inc.*, 808 F.Supp.2d 542 (S.D.N.Y. 2011), *aff'd sub nom Jovani Fashion, Inc. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012) (design of prom dress not protected under copyright). In contrast, a two-dimensional fabric design is routinely considered to be non-functional and subject to copyright protection. *See, e.g., Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) (multicolored striped sweater with puffy leaf appliques and cardigan with squirrel and leaves appliqued on multi-panel front subject to copyright protection); *Folio Impressions, Inc. v. Byer Cal*, 937 F.2d 759, 763 (2d Cir. 1991) (rose design and placement of rose repeated in horizontal lines against an ornate background subject

to copyright protection). Courts have failed, however, to arrive at a consistent and coherent set of standards to evaluate copyrightability where the claimed design is more than a fabric pattern, but less than the structure of a garment.

Likewise, the statute does not tell us what "separability" is or how to identify it. The legislative commentary on the amendment provides that "even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable." H.R. Rep. No. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5668. It is generally accepted that "separable" refers to not just physical separability but also so-called "conceptual" separability. The legislative history notes that "[u]nless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, *physically or conceptually*, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill," but provides no further analysis of how courts should analyze separability. *Id.* (emphasis added). Determinations of physical separability are typically straightforward. In contrast, as discussed below, courts have created a multitude of approaches to articulate and apply "conceptual separability" in practice.

The Copyright Act, therefore, introduces a key term and a key concept without defining either, "intrinsic utilitarian function" and "separability," which has led to great difficulty in consistently ascertaining which features (if any) of a useful article are copyrightable.

B. Courts Have Struggled to Consistently Apply *Mazer v. Stein* and Relevant Statutory Language

In 1990, the Court of Appeals for the Third Circuit observed that "[c]ourts have twisted themselves in knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function." *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 670 (3d Cir. 1990). Twenty-six years later, this is no less true. Indeed, the Fourth Circuit and the dissenting judge of the Sixth Circuit in the instant case have referred to the conceptual separability analysis as no less than a "metaphysical quandary." *See Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 494 (6th Cir. 2015) (McKeague, J., dissenting) (quoting *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010)).

1. The Copyright Office, Courts, and Scholars Have Created Numerous Tests for Conceptual Separability

The Copyright Office, the courts, and several scholars have embraced various tests to determine whether a particular design is conceptually separable from the material object in which that feature is embodied. The most prominent of these are:

1) The Copyright Office's Test: "A pictorial, graphic, or sculptural feature satisfies [the conceptual-separability] requirement only if the artistic feature and the useful article could both exist side by side and be perceived as

fully realized, separate works—one an artistic work and the other a useful article." *Compendium of U.S. Copyright Office Practices* § 924.2(B) (3d ed. 2014).

2) The Primary-Subsidiary Test: A pictorial, graphic or sculptural ("PGS") feature is conceptually separable if the artistic features of the design are "primary" to the "subsidiary utilitarian function." *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993-94 (2d Cir. 1980). In *Kieselstein-Cord*, the Second Circuit determined that the artistic features of a belt buckle were primary to the underlying functionality of the belt buckle itself. *Id.*

Illus. 4 Kieselstein Winchester belt (*available at* http://www.thefashiongrid.com/home/2012/8/24/tfg-exclusive-case-brief.html (last visited Jul. 20, 2016)).

3) The Objectively Necessary Test: In *Carol Barnhart Inc. v. Econ. Cover Corp.*, the Second Circuit, considering plastic human torso forms, found that a PGS feature is conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article. 773 F.2d 411, 419 (2d Cir. 1985). The court found the claimed torso forms uncopyrightable. *Id.*

4) The Ordinary-Observer Test: In the same case, the dissent stated that a PGS feature is conceptually separable if "the design creates in the mind of the ordinary[, reasonable] observer two different concepts that are not inevitably entertained simultaneously." *Id.* at 422 (Newman, J., dissenting).

5) The Design-Process Test: While considering the copyrightability of a bicycle rack, the Second Circuit held that a PGS feature is conceptually separable if the "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987); *see also Pivot Point Int'l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 930-31 (7th Cir. 2004); *see generally* Robert C. Denicola, *Applied Art & Indus. Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 741-45 (1983). The court held that the rack was not entitled to protection because the design had been dictated by functional considerations.

Illus. 5 Bicycle rack (available at brandir.com (last visited Jul. 20, 2016)).

6) The Stand-Alone Test: A PGS feature is conceptually separable if "the useful article's functionality remain[s] intact once the copyrightable material is separated." *Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting). In *Pivot Point*, the court considered hair design mannequins; the dissenting judge would have found that the mannequin faces were not copyrightable using this test. *See id.*

7) The Likelihood-of-Marketability Test: The Fifth Circuit, in considering a prom dress, held that a PGS feature is conceptually separable if "'there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.'" *Galliano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 *Nimmer on Copyright* § 2.08(B])(3])). The Fifth Circuit specifically limited this test to dress design cases. *Id.*

8) The Patry Test: William F. Patry, the author of *Patry on Copyright*, would focus on whether the PGS features are separable from the utilitarian aspects of the article at issue rather than from the overall article. In other words, the protectable features need to be able to stand apart from the functional aspects of the work, but not necessarily from the work itself. As such, a court would first identify the PGS features and then assess whether those features are dictated by the form or function of the utilitarian aspects of the article. 2 *Patry on Copyright* §§ 3-145–46.

9) The Subjective-Objective Test: The court would consider whether the designer was motivated by aesthetics or functional concerns and then assess the extent to which the design is dictated by the function. Barton R. Keyes, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 Ohio St. L.J. 109, 141 (2008).

10) The Goldstein Test: Copyright Scholar Paul Goldstein has advocated that courts should inquire whether "the artistic features 'can stand alone as a work of art traditionally conceived, and ... the useful article in which it is embodied would be equally useful without it.'" *Pivot Point*, 372 F.3d at 923 (quoting 1 Paul Goldstein, Copyright: Principles, Law & Practice § 2.5.3, at 2:67 (1989)) (alteration in original).

2. Certain of the Existing Tests Are Problematic, Inefficient, and Lead to Inconsistent Results

To be clear, the "tests" identified above do not, in the Association's view, describe ten wildly divergent philosophies of copyright law. Indeed, courts often apply many approaches and tests simultaneously, recognizing that "even when [] judges have disagreed on the appropriate application of the Congressional Mandate to the case before them, their insight yields a bountiful harvest for those of us who now walk the same interpretative path." *Pivot Point Int'l, Inc. v. Charlene Products, Inc.*, 372 F. 3d 913 (7th Cir. 2004); *see also Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 487-89 (6th Cir. 2015); *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 433-

35 (4th Cir. 2010); *Chosun International, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 329-30 (2d Cir. 2005); *Jovani Fashion, Inc. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 549-52 (S.D.N.Y. 2011), *aff'd Jovani Fashion, Inc. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012).

That being said, the multitude of tests creates unpredictable results. Because the courts and the Copyright Office have different tests, it is uncertain whether and to what extent designs that combine utilitarian functionality with potentially protectable expression are protected. Authors of creative designs struggle to identify which elements, if any, of the design are copyrightable. To make matters worse, even if some portion of the design is deemed protectable by one authority, another authority might conclude that it is not.

Moreover, several of the above tests are flawed because they require those assessing copyrightability to look beyond the work in question to draw conclusions about an author's intention or the public's perception. Separability, as described in the Copyright Act, is an inherent quality of a work of authorship; it does not live or die in the eye of the artist, a reasonable observer, or any third party. As this Court has noted with respect to originality:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive

> until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903). Proper inquiries, therefore, focus on the claimed design of the object itself and ask whether it is capable of being separated in some manner.

The Association recommends adopting a framework that is consistent with the Copyright Act and fosters judicial economy, consistency, and greater predictability. A framework that begins with a narrow inquiry into what precisely is being claimed, and only then expands to whether and how the claimed design is integrated with an underlying useful article allows courts to avoid unnecessary factual determinations.

To the extent that the law can be applied in a manner that better enables the public to understand what the protectable aspects of a given object's design are, designers of industrial goods will have greater confidence that their creations do not infringe. However, when the contours of a design's protectability are shaped by a particular individual's perceptions or thoughts, then such confidence is difficult to achieve.

a. This Court Should Not Endorse Likelihood of Marketability in Determining Conceptual Separability

The "likelihood of marketability" test put forth by Nimmer and adopted by the Fifth Circuit in *Galiano* invites a subjective judgment about perceived artistic merit that is not probative of separability and is wholly out of place in copyright law. *See Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 *Nimmer on Copyright* § 2.08[B])(3), at 2-101). This test would ask courts to ascertain the salability of a work's design elements apart from the work as a whole.

The legislative history of the Copyright Act speaks to this very issue: "the definition of 'pictorial, graphic, and sculptural works' carries with it no implied criterion of artistic taste, aesthetic value, or intrinsic quality." H.R. Rep. No. 94-1476, at 54 (1976), reprinted in 1976 U.S.C.C.A.N. 5667. An ugly work or a location-specific work might not be salable; that would not justify depriving the work of otherwise appropriate copyright protection. *See, e.g., Mazer v. Stein*, 347 U.S. 201, 213 (1954) ("Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art."); *see also* Darren Hudson Hick, *Conceptual Problems of Conceptual Separability and the Non-Usefulness of the Useful Articles Distinction*, 57 J. Copyright Soc'y 37, 41-42 (citing Barton R. Keyes, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 Ohio St. L.J. 109, 141 (2008)).

b. This Court Should Not Endorse the "Ordinary Observer" in Determining Conceptual Separability

The ordinary observer test is flawed in that it introduces an irrelevant and uncertain element into the copyrightability analysis. In the case of plagiarized art or text, for example, copyrightability analysis begins and ends with an assessment of the work itself. An "ordinary observer's" observation of the work has no import or value, save perhaps in determining whether plaintiff's and defendant's works are substantially similar in cases of claimed infringement. Examining a claimed design through the eyes of the "ordinary observer" draws courts away from the essential task of considering the intrinsic elements of the work and mixes in concepts more properly found in the trademark context, such as considering the reactions of "reasonable consumers." *See supra* Part I.B.2 (discussing concerns with reliance on public opinion in determining whether a particular work merits copyright protection). Finally, practical complexities hinder the use of the "ordinary observer" test—for example, who is an ordinary observer in the context of cheerleading uniform design? People who attend sporting events? Potential purchasers of cheerleading uniforms? Both? Are consumer surveys necessary or appropriate? The ordinary observer test sheds smoke, but, in this context, provides little light. It should be rejected.

c. This Court Should Not Endorse Either the Design Process or the Subjective-Objective Tests in Determining Conceptual Separability

Both the design-process test and the "subjective" portion of the subjective-objective test are contrary to the legislative history of the Copyright Act. The Copyright Act's history provides that "even if the appearance of an article is determined by aesthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable." H.R. Rep. No. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5667, 5668. Moreover, an author's focus or intent in creating a work does not logically yield any determinative information about the nature of the resulting work. This type of test could easily yield divergent determinations on the copyrightability of highly similar works depending on what the author is attributed by the court to have thought while creating the work.

II. The Sixth Circuit's Framework is Flawed

In response to the present question of conceptual separability in connection with cheerleading uniforms, the U.S. Court of Appeals for the Sixth Circuit devised a new framework to assess copyrightability of the design of a useful article.

A. The Sixth Circuit's Framework

The Sixth Circuit employs a five question inquiry to determine whether the design of a useful article is entitled to copyright protection:

(1) Is the design a pictorial, sculptural or graphic work?

(2) If it is, is it a design of a useful article?

(3) What are the utilitarian aspects of the useful article?

(4) Can the viewer of the design identify pictorial, graphic or sculptural features separately from the utilitarian aspects of the useful article? and

(5) Can the pictorial, sculptural or graphic features of the design of the useful article exist independently of the utilitarian aspects of the useful article?

Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468, 487-89 (6th Cir. 2015).

To answer the question of separability raised in Questions 4 and 5, the Sixth Circuit took a "hybrid" approach, blending together certain of the above-described tests. Specifically, the Sixth Circuit endorsed application of the objectively necessary approach adopted by the Second Circuit in *Carol Barnhart*; aspects of the design process approach as applied in *Pivot Point*; and the Copyright Office's approach, and eschewed the likelihood of marketability approach for the same reasons that the Association rejects that approach. *See id.*; *see also supra* Part I.B.2.a.

B. The Sixth Circuit's Framework Is Inefficient and May Lead to Inconsistent Results

The copyrightability analysis for the design of a three dimensional object should begin with an identification of the claimed design elements. The claimed design is the crux of the inquiry; the question before any authority is always "is the claimed design protectable?"

The Sixth Circuit test is designed to answer a different inquiry entirely, namely, "what aspects of this article's design *cannot* be covered by copyright?" Under the Sixth Circuit's test, courts may mistakenly conclude that they must opine on the functionality of the entire article in question, and then attempt to dissect from it the portions that may be copyrightable. Such a test would be an exercise in abstraction that not only wades into quandaries that may have nothing to do with the case at bar, but would also detract from the primary focus in every other copyrightability analysis, namely, the design actually being claimed. In other words, the Sixth Circuit's analysis is inverted in trying to extract the claimed design from what it perceives to be its "useful" surroundings.

The Sixth Circuit test is flawed for another important reason: it conflicts with the language of 17 U.S.C. §§ 101 and 113. 17 U.S.C. § 101 states that a "useful article" is one having "an intrinsic utilitarian function." Section 101 also establishes that "[a]n article that is *normally a part of a useful article* is considered a 'useful article.'" (emphasis added). Therefore, the statute recognizes that not every part of a "useful article" necessarily has an "intrinsic utilitarian function." With that in mind, and considering that neither Section 101 nor Section 113 outright prohibits

copyright protection in "useful articles," it becomes apparent that any test that seeks to first determine an entire article's "intrinsic utilitarian function" is an unfocused exercise; such tests can potentially preclude copyrightability in parts of the article that, in reality, have no "intrinsic utilitarian function." To avoid such a result, and to stay true to the language of Sections 101 and 113, the principal inquiry should simply be the whether the claimed design is copyrightable.

For example, consider two bracelets that appear identical. One is simply ornamental jewelry. The other is in fact a wearable device that monitors a person's heart rate and other biometrics. If a court starts its copyright analysis by considering the design, there is no question that the design of the ornamental jewelry is protectable (assuming it is sufficiently original). *See, e.g.*, *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2002) (finding that plaintiff possessed valid copyrights in jewelry designs). For the wearable device, if a court starts by identifying and examining the design (as proposed by this brief), it should be clear that the design is entirely separable—and there is no need to delve into the object's utility to arrive at that conclusion. In contrast, if a court were to follow the Sixth Circuit's approach, it would begin by attempting to determine the utilitarian purpose of the device. A court could conclude that the device's purpose is any number of things: to collect biometric data, to be a wearable health monitor, etc. The court might therefore conclude that, to serve its purpose, the device must be round, and would therefore be far more likely to mistakenly conclude that some lesser amount of the design, if any, is copyrightable.

The Sixth Circuit framework assumes that every copyright claimant will always assert rights in the overall design of the article in question, and that it is therefore always necessary to analyze every aspect of an article's utility in each and every instance. This assumption is not correct: in many instances, copyright is sought for something less than the entire useful article (i.e., the carving on a chair, the painting on a decorative plate, or the arrangement of chevrons and stripes on a cheerleading uniform, rather than the entirety of the chair, plate, or uniform). The Sixth Circuit test, therefore, is ill-suited for common situations where copyright protection is sought for something less than the entire article.

The Sixth Circuit approach is also inefficient. It is not always necessary for courts to digress into lengthy analyses of utility. For example, in *Universal Furniture International, Inc. v. Collezione Europa USA, Inc.*, the Fourth Circuit started its analysis by identifying the claimed design, as recommended here: "compilations of decorative elements adorning utilitarian furniture." 618 F.3d 417, 433 (4th Cir. 2010). It distinguished the claimed design from the shape or industrial design of the furniture. With that established, it quickly moved through a conceptual separability analysis without any need to consider the utilitarian aspects of furniture. The Sixth Circuit, in contrast, would have the court first identify the type of work the design would be if ultimately protectable, that is, a pictorial, graphic, or sculptural work. Then the court would decide that furniture is "useful." Next, it would set about identifying the utilitarian aspects of the furniture. From there it would ask if anything can be separated out. Not only would a digression into what makes breakfronts useful have been unnecessary in this

instance, but the court might instead have concluded that the plaintiff held a broader copyright than it asserted if the court identified some other aspect of the design that was separable. Such an unnecessary and discursive analysis is not in the interest of judicial economy.

Even in more complex cases, courts have not necessarily felt the need to specifically articulate a useful article's utilitarian function. In its seminal decision in *Kieselstein-Cord*, for example, the Second Circuit spent no time dissecting the belt buckle's function; rather it focused primarily on the claimed design. 632 F.2d 989. This is appropriate and efficient.

This is not to say that utility is irrelevant or that courts may not need to delve into that issue in certain circumstances, but the claimed design must be the focus of the inquiry.

III. The Association Proposes a Test Centered on the Claimed Design

The Association respectfully submits that a proper copyrightability analysis for the design of a three dimensional article should begin with an identification of the claimed design elements, rather than of a definition of the underlying useful article.

Specifically, the Association submits that copyrightability of design of a useful article should be assessed as follows:

(1) What are the design elements in which copyright is claimed?

(2) Are those elements original and fixed in a tangible medium of expression?

(3) Are those design elements inextricably intertwined with a utilitarian function of the object in which they are fixed such that they cannot be identified or exist apart from the object's utilitarian features?

When making a determination on this third question, courts should be free to consider, without limitation, the following factors:

(a) Whether the claimed design elements are physically separable from the overall object (*See Mazer v. Stein*, 347 U.S. 201 (1954); U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 924.2(A) (3d ed. 2014) ("*Compendium (Third)*"));

(b) Whether the claimed design elements are primary to a subsidiary function of the work (*See Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980); *see generally* Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 744-45 (1983));

(c) Whether the claimed design and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article (*See Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468,

489 (6th Cir. 2015) (citing *Compendium (Third)* § 924.2(B))); and

(d) The extent to which the design at issue is dictated by the utilitarian aspects of the work (*See* 2 Patry on Copyright § 3.146).

The test's third question focuses the inquiry on whether the claimed design elements can be "identified separately from" (*see Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) and "exist independently of" (*see* H.R. Rep. No. 94-1476, at 54 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5667) the utilitarian aspects of the work. *See, e.g., Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 494 (4th Cir. 1996) (finding sculptural features of animal mannequins to be conceptually separable from their utilitarian function of supporting mounted taxidermy skins). This inquiry is posed as a single question, in contrast to the Sixth Circuit's, which makes two distinct inquiries, first into separate identification and then into independent existence. The Association agrees with the Seventh Circuit and other courts that have concluded that "Congress, in amending the statute, intended these two phrases to state a single, integrated standard to determine when there is sufficient separateness between the utilitarian and artistic aspects of a work to justify copyright protection." *See Pivot Point Int'l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 922 (7th Cir. 2004); *Superior Form Builders*, 74 F.3d at 494 (4th Cir. 1996); *Brandir Intern., Inc. v. Cascade Pacific Lumber Co*, 834 F.2d 1142 (2nd Cir. 1987); *Norris Industries, Inc. v. International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir. 1983).

CONCLUSION

The Association respectfully requests this Court to resolve the problems created by inadequate separability tests and by the proliferation of tests itself by endorsing a copyrightability analysis, such as the one suggested in this brief, that properly interprets the statutory framework set out in the Copyright Act.

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